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Supreme Court, U. S.
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CHARLES ELMORE CROPLEY
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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1951.

No. 620

BROWN & BIGELOW,
Petitioner,

v.

B. B. PEN COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.

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INDEX.

Page

Petition for writ of certiorari 1-5

Summary statement of the matter involved 1

Basis upon which it is contended this court has jurisdiction 2

Questions presented 3

Reasons relied on for allowance of writ 4

Petitioner's brief in support of its petition for certiorari 6-7

Cases Cited.

Erie R. R. Co. v. Tompkins, 304 U. S. 64, 82 L. ed. 1188, 58 S. Ct. 817 ..... 4, 5, 7

Guild v. Federal Trade Commission, 312 U. S. 457, 85 L. ed. 949, 61 S. Ct. 703 ..... 3, 4, 5, 7

Northwest Knitting Co. v. Garon, 112 Minn. 321, 228 N. W. 288 ..... 4, 6

Pecheur Lozenge Co. v. National Candy Co., 315 U. S. 666, 86 L. ed. 1103, 62 S. Ct. 853 ..... 3, 4, 7

Rodseth v. Northwestern Marble Works, 152 N. W. 885, 129 Minn. 472 ..... 4, 6

Sheffield-King Milling Co. v. Sheffield M. & E. Co., 117 N. W. 447, 105 Minn. 315 ..... 4, 6

Statutes Cited.

Statute, June 25, 1948, c. 646, 62 Stat. 928 (U. S. C. A., Title 28, Sec. 1254) 2

Statute, June 25, 1948, c. 646, 62 Stat. 961, amended May 24, 1949, c. 139, Sec. 106, 63 Stat. 104 (U. S. C. A., Title 28, Sec. 2101) 3

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

To the Honorable the Supreme Court of the United States:

Your petitioner respectfully shows:

I.

Summary Statement of the Matter Involved.

This is a declaratory judgment action brought in the Federal District Court in Minnesota by respondent against petitioner to have adjudged its ownership of and right to the use of the symbol "B·B" as a trade-mark or trade

name for the Ball Point Pen manufactured and sold by it. It also asks that it be declared as not having engaged in unfair competition with petitioner and that it has not infringed upon any rights of the petitioner.

Petitioner asserts by counterclaim its ownership and right to the use of the trade name or symbol "B & B" in its manufacture and sale of Ball Point Pens and other articles. It asks that it be declared the owner thereof, and accuses the respondent of infringement and unfair competition.

The case was tried to the District Court without a jury, and the Court, after hearing the evidence, entered a judgment dismissing both respondent's complaint and petitioner's counterclaim without costs to either party. The petitioner, after its motion for a new trial on its counterclaim was denied, appealed from so much of the judgment as dismissed its counterclaim to the United States Court of Appeals for the Eighth Circuit. The Court of Appeals affirmed the judgment of the District Court. The judgment of affirmance was entered November 2, 1951. Petitioner applied for a rehearing in due course. This was denied by order of the Court of Appeals entered on December 3, 1951. It is sought by this petition to have the judgment of the Court of Appeals reviewed by this Court.

II.

Basis Upon Which It Is Contended This Court Has Jurisdiction.

The judgment of the Court of Appeals was entered November 2, 1951. Order of the Court of Appeals denying petitioner's application for rehearing was entered December 3, 1951.

Jurisdiction of this Court to entertain this matter is based on the provisions of Statute, June 25, 1948, c. 646, 62 Stat. 928 (U. S. C. A., Title 28, Sec. 1254); and Statute,

June 25, 1948, c. 646, 62 Stat. 961, amended May 24, 1949, c. 139, Sec. 106, 63 Stat. 104 (U. S. C. A., Title 28, Sec. 2101).

III.

Questions Presented.

1. The case is one of alleged unfair competition under the common law, by infringement of a trade name, and jurisdiction of the Federal Court is based solely upon diversity of citizenship. The question presented on this application is whether or not Minnesota decision law, the law of the forum, should have been applied in determining the issues in the case, as to unfair competition. Petitioner's contention is that this was not done by either the District Court or the Court of Appeals, and it contends that such law should have been applied in determining such issues, and that, if it had been applied, a decision in favor of petitioner on its counterclaim would have been compelled.

2. The answer to this basic question might be said to involve the answer to this question:

Is not the law of Minnesota of trade names that where the trade names are identical or substantially so, and the products and the trade areas identical, then likelihood of confusion, with resultant infringement or unfair competition on the part of the later user, is established as a matter of law, regardless of whether specific trade marks are also used, and regardless of variants in methods of distribution of products?

As to Questions 1 and 2 see:

Pecheur Lozenge Co. v. National Candy Co., 315 U. S. 666, 86 L. ed. 1103, 62 S. Ct. 853;

Guild v. Federal Trade Commission, 312 U. S. 457, 85 L. ed. 949, 61 S. Ct. 703;

Erie R. R. Co. v. Tompkins, 304 U. S. 64, 82 L. ed. 1188, 58 S. Ct. 817;

Northwest Knitting Co. v. Garon, 112 Minn. 321, 228 N. W. 288;

Rodseth v. Northwestern Marble Works, 152 N. W. 885, 129 Minn. 472; and

Sheffield-King Milling Co. v. Sheffield M. & E. Co., 117 N. W. 447, 105 Minn. 315;

See also brief hereto attached in support of this petition.

3. Did the Federal Trademark Act of 1946 change the rule of the cases of—

Pecheur Lozenge Co. v. National Candy Co., 315 U. S. 666, 86 L. ed. 1103, 62 S. Ct. 853;

Guild v. Federal Trade Commission, 312 U. S. 457, 85 L. ed. 949, 61 S. Ct. 703;

Erie R. R. Co. v. Tompkins, 304 U. S. 64, 82 L. ed. 1188, 58 S. Ct. 817,

that, in cases involving tortious conduct such as unfair competition and the common law of trade names, the local law applies?

IV.

Reasons Relied on for Allowance of Writ.

1. Failure on the part of the Court of Appeals to apply Minnesota decision law in determining the issues presented in the case. If Minnesota law had been applied, these issues, as we see it, would necessarily have been decided in favor of the petitioner herein, and judgment necessarily would have been entered accordingly.

2. The Court of Appeals for the Eighth Circuit in deciding the case failed to apply or misconstrued authoritative Supreme Court decisions, namely:

Pecheur Lozenge Co. v. National Candy Co., 315 U. S. 666, 86 L. ed. 1103, 62 S. Ct. 853;

Guild v. Federal Trade Commission, 312 U. S. 457, 85 L. ed. 949, 61 S. Ct. 703;

Erie R. R. Co. v. Tompkins, 304 U. S. 64, 82 L. ed. 1188, 58 S. Ct. 817.

Wherefore, Your petitioner prays that a writ of certiorari issue under the seal of this Court, directed to the United States Court of Appeals for the Eighth Circuit, commanding said Court to certify and send to this Court a full and complete transcript of the record and of the proceedings of said Court of Appeals had in the case numbered and entitled on its Docket No. 14,323 Civil, Brown & Bigelow, Appellant, v. B. B. Pen Company, Appellee, to the end that this cause may be reviewed and determined by this Court as provided by the statutes of the United States; and that the judgment herein of said Court of Appeals be reversed by this Court, and for such further relief as this Court may deem appropriate.

Dated February 27, 1952.

Respectfully submitted,

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ESTILL E. EZELL,
Attorneys for Petitioner.

PETITIONER'S BRIEF IN SUPPORT OF ITS PETITION FOR CERTIORARI.

Briefly, the undisputed facts are:

The trade names "B & B" and "B·B" are, for all practical purposes, identical; and the products involved are the same, ball point pens, and the trade areas of petitioner and respondent are identical. Petitioner has been using the trade name "B & B" on various articles, manufactured and sold by it, including pencils, pen holders and the like, since 1918; and has been using such trade name on its ball point pens since 1946. Not until 1947 did respondent begin to use the trade name "B·B". During that year, it began to use the same on its ball point pens. And it began then to designate itself as "B. B. Pen Co." Petitioner was the prior user, and has prior right to the use of the trade name "B & B", over the trade name "B·B".

On the basis of the facts such as these, the rule is that likelihood of confusion, and hence infringement or unfair competition by the later user is established as a matter of law.

Northwestern Knitting Co. v. Garon, 112 Minn. 321, 128 N. W. 288;
Rodseth v. Northwestern Marble Works, 152 N. W. 885, 129 Minn. 472; and
Sheffield-King Milling Co. v. Sheffield M. & E. Co., 117 N. W. 447, 105 Minn. 315.

Contrary to Minnesota law of unfair competition, the decision below gave effect to factors immaterial to the application of the Minnesota rule by which likelihood of confusion must be determined (e. g., use of other specific trade marks; evidence of experts; and asserted different methods of distribution).

Under Minnesota law these elements cannot be set against the elementary facts of this case to overcome the legal conclusion of likelihood of confusion.

The rule of this Court, as we understand it, is that in common law trade mark or unfair competition cases local law applies.

Pecheur Lozenge Co. v. National Candy Co., 315 U. S. 666, 86 L. ed. 1103, 62 S. Ct. 853;
Guild v. Federal Trade Commission, 312 U. S. 457, 85 L. ed. 949, 61 S. Ct. 703; and
Erie R. R. Co. v. Tompkins, 304 U. S. 64, 82 L. ed. 1188, 58 S. Ct. 817.

In the situation here presented, the local law was that of Minnesota.

It is the position of petitioner that the Court of Appeals for the Eighth Circuit erred in not applying the local law of Minnesota in determining the issues in the case.

It is respectfully submitted that writ of certiorari to the Court of Appeals for the Eighth Circuit should issue.

Respectfully,

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